

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF WISCONSIN**

NORTHWOODS HEATING & COOLING, LLC,

Plaintiff,

Case No. 21-CV-484

v.

COMPLAINT

NORTHWOODS HEATING & AIR
CONDITIONING, LLC,

JURY TRIAL DEMANDED

Defendant.

Plaintiff Northwoods Heating & Cooling, LLC (“Northwoods Heating & Cooling”) alleges the following against defendant Northwoods Heating & Air Conditioning, LLC (“NH&AC”):

THE PARTIES

1. Northwoods Heating & Cooling, LLC (“Northwoods Heating & Cooling”) is a limited liability company organized under the laws of the State of Wisconsin with its principal place of business at 8682 E. Flowage Lane, Gordon, WI 54838.

2. Northwoods Heating & Air Conditioning, LLC (“NH&AC”) is a limited liability company organized under the laws of the State of Wisconsin with its principal place of business 6682 S. County Road B, Foxboro, WI 54836.

JURISDICTION AND VENUE

3. This action arises under the Lanham Act, 15 U.S.C. § 1051 *et seq.*, and under Wisconsin’s common law of unfair competition. This Court has subject matter jurisdiction over the federal claims under 28 U.S.C. §§ 1331, 1137, and 1338(b) and 15 U.S.C. § 1121. This Court has supplemental jurisdiction over the state law claims under 28 U.S.C. § 1367.

4. This Court has personal jurisdiction over NH&AC because it is a under organized under the laws of the State of Wisconsin; has its principal place of business in this district; regularly solicits and transacts business in this district; and has committed numerous acts of trademark infringement at issue in this district.

5. Venue is proper in this district under 28 U.S.C. § 1391 at least for the reasons this Court has personal jurisdiction.

FACTUAL BACKGROUND

Northwoods Heating & Cooling's Trademark Rights

6. Northwoods Heating & Cooling has used NORTHWOODS HEATING & COOLING in commerce since at least September 2017.

7. Northwoods Heating & Cooling filed an application to federally register its NORTHWOODS HEATING & COOLING trademark on March 13, 2020.

8. Northwoods Heating & Cooling's U.S. Trademark Registration No. 6,168,104 to NORTHWOODS HEATING & COOLING issued on October 6, 2020. Attached as **Exhibit A** and hereby incorporated by reference is the certificate of registration for U.S. Trademark Reg. No. 6,168,104.

9. Examples of Northwoods Heating & Cooling use are shown below:





NH&AC's Activities

10. According to the publicly available records from the Wisconsin Department of Financial Institutions, NH&AC was organized on May 14, 2019.

11. Without authorization from Northwoods Heating & Cooling, NH&AC has used the name "Northwoods Heating & Air Conditioning" to market at least HVAC contractor services, installation and repair of heating, ventilating, and air conditioning equipment, examples of which are shown below:





12. Northwoods Heating & Cooling became aware of NH&AC using the name “Northwoods Heating & Air Conditioning” to market HVAC contractor services, installation and repair of heating, ventilating, and air conditioning equipment around March 2020.

13. On April 6, 2020, Northwoods Heating & Cooling (through its counsel) sent a letter to NH&AC demanding NH&AC discontinue use all use of “Northwoods” in connection with sales, installation, and services of heating and cooling systems. Attached as **Exhibit B** and hereby incorporated by reference is a copy of the letter sent to NH&AC.

14. On April 9, 2020, NH&AC responded (though its counsel) that not only did it not infringe any trademark rights of Northwoods Heating & Cooling, but that Northwoods Heating & Cooling was infringing NH&AC’s “registered trademark” and demanded Northwoods Heating & Cooling cease using NH&AC’s trademark. Attached as **Exhibit C** and hereby incorporated by reference is a copy of the response from NH&AC.

15. On April 9, 2020, NH&AC (though its counsel) filed for record a statement of adoption of the trademark “Northwoods Heating & Air Conditioning, LLC” with the Wisconsin Department of Financial Institutions. Attached as **Exhibit D** and hereby incorporated by reference is a copy of certification of NH&AC’s recordation.

16. On December 3, 2020, counsel for Northwoods Heating & Cooling sent a letter to counsel for NH&AC informing NH&AC that Northwoods Heating & Cooling owned U.S. Trademark Registration No. 6,168,104 and again demanding NH&AC cease all use of the term “Northwoods Heating & Air Conditioning.” Attached as **Exhibit E** and hereby incorporated by reference is a copy of the letter sent to NH&AC.

17. On December 3, 2020, counsel for NH&AC indicated in an email that he was not currently representing NH&AC and to contact NH&AC directly. Attached as **Exhibit F** and hereby incorporated by reference is a copy of the email sent by counsel for NH&AC.

18. On December 8, 2020, Northwoods Heating & Cooling (through its counsel) sent a letter to NH&AC informing NH&AC that it owned U.S. Trademark Registration No. 6,168,104 and again demanding NH&AC cease all use of the term “Northwoods Heating & Air Conditioning.” Attached as **Exhibit G** and hereby incorporated by reference is a copy of the letter sent to NH&AC.

19. To date, NH&AC continues its unauthorized use of the term “Northwoods Heating & Air Conditioning” in connection with at least sales, installation, and services of heating and cooling systems, which has had a substantial effect on Northwoods Heating & Cooling’s business and caused actual confusion of customers and vendors as to the source of the services.

COUNT I
INFRINGEMENT OF REGISTERED TRADEMARK
UNDER 15 U.S.C. § 1114(a)

20. Northwoods Heating & Cooling restates and hereby incorporates by reference the allegations from the preceding paragraphs as if fully set forth herein.

21. Northwoods Heating & Cooling owns valid and protectable trademark rights to NORTHWOODS HEATING & COOLING through its continuous use in interstate commerce and Wisconsin.

22. Northwoods Heating & Cooling owns all right, title, and interest to federal trademark rights to NORTHWOODS HEATING & COOLING, including U.S. Trademark Registration No. 6,168,104.

23. Without Northwoods Heating & Cooling's authorization, NH&AC uses "Northwoods Heating & Air Conditioning" in commerce in connection with sales, installation, and services of heating and cooling systems.

24. NH&AC's unauthorized use is likely to cause confusion, mistake, or deception related to Northwoods Heating & Cooling's U.S. Trademark Registration No. 6,168,104 in violation of 15 U.S.C. § 1114.

25. As a direct and proximate result of NH&AC's unauthorized use, Northwoods Heating & Cooling has suffered and will continue to suffer harm, including lost sales and market share and damage to reputation and good will. Northwoods Heating & Cooling has also suffered and will continue to suffer irreparable harm for which there is no adequate remedy at law. Northwoods Heating & Cooling is entitled to injunctive relief under 15 U.S.C. § 1116.

26. Northwoods Heating & Cooling is entitled to recover damages it has sustained due to NH&AC's wrongful acts NH&AC's profits under 15 U.S.C. § 1117(a).

27. Northwoods Heating & Cooling is entitled to recover treble damages and profits under 15 U.S.C. § 1117(a) because NH&AC's wrongful acts demonstrate willful intent to trade on the goodwill associated with the NORTHWOODS HEATING & COOLING registered mark.

28. Under 15 U.S.C. § 1117, Northwoods Heating & Cooling is also entitled to recover its costs of suit and its attorneys' fees because this is an exceptional case.

COUNT II
INFRINGEMENT OF TRADEMARK
UNDER 15 U.S.C. §1125(a)

29. Northwoods Heating & Cooling restates and hereby incorporates by reference the allegations of paragraphs 1 through 19 as if fully set forth herein.

30. Northwoods Heating & Cooling owns valid and protectable trademark rights to NORTHWOODS HEATING & COOLING through its continuous use in interstate commerce and Wisconsin.

31. Without Northwoods Heating & Cooling's authorization, NH&AC uses "Northwoods Heating & Air Conditioning" in commerce in connection with sales, installation, and services of heating and cooling systems.

32. NH&AC's unauthorized use is likely to cause confusion, mistake, or deception as to Northwoods Heating & Cooling's affiliation, connection, origin, sponsorship, or approval of NH&AC's wrongful acts violation of 15 U.S.C. § 1125(a).

33. As a direct and proximate result of NH&AC's use, Northwoods Heating & Cooling has suffered and will continue to suffer harm, including lost sales and market share and damage to reputation and good will. Northwoods Heating & Cooling has also suffered and will continue to suffer irreparable harm for which there is no adequate remedy at law. Northwoods Heating & Cooling is entitled to injunctive relief under 15 U.S.C. § 1116.

34. Northwoods Heating & Cooling is entitled to recover damages it has sustained due to NH&AC's wrongful acts and NH&AC's profits under 15 U.S.C. § 1117(a).

35. Northwoods Heating & Cooling is entitled to recover treble damages and profits under 15 U.S.C. § 1117(a) because NH&AC's wrongful acts demonstrate willful intent to trade on the goodwill associated with the NORTHWOODS HEATING & COOLING mark.

36. Under 15 U.S.C. § 1117, Northwoods Heating & Cooling is also entitled to recover its costs of suit and its attorneys' fees because this is an exceptional case.

COUNT III
TRADEMARK INFRINGEMENT, DECEPTIVE TRADE PRACTICES, AND UNFAIR
COMPETITION UNDER COMMON LAW

37. Northwoods Heating & Cooling restates and hereby incorporates by reference the allegations of paragraphs 1 through 19 as if fully set forth herein.

38. Northwoods Heating & Cooling owns valid and protectable trademark rights to NORTHWOODS HEATING & COOLING through its continuous use in interstate commerce and Wisconsin.

39. Northwoods Heating & Cooling owns federal trademark rights to NORTHWOODS HEATING & COOLING, including U.S. Trademark Registration No. 6,168,104.

40. Without Northwoods Heating & Cooling's authorization, NH&AC uses "Northwoods Heating & Air Conditioning" in Wisconsin in connection with sales, installation, and services of heating and cooling systems.

41. NH&AC's unauthorized use is at least likely to cause confusion, mistake, or deception as to Northwoods Heating & Cooling's affiliation, connection, origin, sponsorship, or approval with respect to NH&AC and its unauthorized use and constitutes trademark infringement, deceptive trade practices, and unfair competition.

42. As a direct and proximate result of NH&AC's use, Northwoods Heating & Cooling has suffered and will continue to suffer harm, including lost sales and market share and damage to reputation and good will. Northwoods Heating & Cooling has also suffered and will continue to suffer irreparable harm for which there is no adequate remedy at law.

43. Northwoods Heating & Cooling is at least entitled to damages, injunctive relief, and its costs and attorneys' fees.

JURY DEMAND

44. Pursuant to Federal Rule of Civil Procedure 38(b), Northwoods Heating & Cooling demands a jury trial for all issues so triable.

PRAYER FOR RELIEF

WHEREFORE, Northwoods Heating & Cooling prays for judgment as follows:

- a. Judgment that NH&AC has infringed Northwoods Heating & Cooling's registered trademark under 15 U.S.C. § 1114;
- b. Judgement that NH&AC has infringed Northwoods Heating & Cooling's trademark under 15 U.S.C. § 1125(a);
- c. Judgment that NH&AC has engaged in trademark infringement, deceptive trade practices, and unfair competition under Wisconsin common law;
- d. Injunctive relief under 15 U.S.C. § 1116 and other applicable laws, preliminarily and permanently enjoining NH&AC and its agents, officers, employees, representatives, successors, assigns, attorneys, and all other persons acting in concert or privity with NH&AC, from: (1) using "Northwoods Heating & Cooling," or any similar variations thereof, including "Northwoods Heating & Air Conditioning," in connection with in connection with sales, installation, and services of heating and cooling systems; (2) using any trademark that imitates or

is confusingly similar to “Northwoods Heating & Cooling” or is likely to cause confusion, mistake, deception, or public misunderstanding as to the origins NH&AC’s sales, installation, and services of heating and cooling systems or its relatedness to Northwoods Heating & Cooling; and (3) engaging in trademark infringement, unfair competition, false designation of origin, deceptive trade practices, or other activities that misappropriate Northwoods Heating & Cooling’s trademark rights.

- e. Damages under 15 U.S.C. § 1117 and other applicable laws, including prejudgment and post-judgment interest, against NH&AC and in favor of Northwoods Heating & Cooling in an amount to be determined at trial;
- f. Disgorgement of NH&AC’s profits under 15 U.S.C. § 1117 and other applicable laws;
- g. Costs and attorneys’ fees under 15 U.S.C. § 1117 and other applicable laws;
- h. Statutory damages under 15 U.S.C. § 1117;
- i. Treble damages, profits, and all other monetary relief under 15 U.S.C. § 1117 and other applicable laws; and
- j. Such other and further relief as the Court may deem just and proper.

Respectfully Submitted,

Dated: August 2, 2021

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**application for admission forthcoming*